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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,162	08/24/2001	Johannes Laurenz Kellenberger	0380-P02380U	5244

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EXAMINER

KERR, KATHLEEN M

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 08/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,162

Applicant(s)

KELLENBERGER ET AL.

Examiner

Kathleen M Kerr

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1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26,28 and 29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application Status

1. A preliminary amendment was filed on January 5, 2001 (Paper No. 6) canceling Claim 27, amending Claims 4-9, 12-15, 18, 19, and 24, and adding Claims 28 and 29. Thus, Claims 1-26 and 28-29 are pending in the instant application.

Restriction

2. Restriction is required under 35 U.S.C. § 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 4-19, and 28, drawn to nucleic acid molecules encoding a type I polyketide synthase (PKS) whose reduction domain(s) are replaced with polylinker regions, vectors, and host cells thereof as well as methods of making said molecules.

Group II, claim(s) 3, drawn to nucleic acid molecules encoding a type I PKS having a polylinker region connecting acyltransferase and acyl carrier protein regions of the PKS.

Group III, claim(s) 20, 24-26 and 29, drawn to methods of making a fermentation product containing a polyketide.

Group IV, claim(s) 21-22, drawn to C22-C23-dihydroavermectins.

Group V, claim(s) 23, drawn to B1 avermectins substantially free of B2 avermectins.

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3. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

“A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involved at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed inventions, considered as a whole, makes over the prior art” (see M.P.E.P. § 1893.03(d)). If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims (see PCT Article 17(3)(a) and 37 C.F.R. § 1.476(c)).

In the instant case, a product is the first claimed invention (Group I); said product has particular characteristics not shared with the other product Groups II, IV, and V. Particularly, in Group I, the technical feature of the product is its structure – the replacement of the KR domain for a polylinker region. The structure of Group II does not share this feature. The products of Groups IV and V are wholly different products, not nucleic acid molecules at all, but polyketides with wholly distinct chemical compositions.

The first claimed methods relating to the first claimed invention, the product of Group I, are the methods of Group I, Claims 18-19. The methods of Group III are distinct from Claims 18 and 19 with different method steps producing different products. While the technical feature of

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Group I is used in the methods of Group III, the methods of Group III are mentioned second in the claims and need not be grouped with the first claimed invention and its technical feature.

Election

4. A telephone call was made to Patrick Hagan on August 8, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

Conclusion

5. Claims 1-26 and 28-29 are restricted. A complete response to the instant Office action must include an election of invention to be examined.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229.

The examiner can normally be reached on Monday through Friday, from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

KMK

August 8, 2002

